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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,814

02/04/2005

Hideki Ishihara

265530US0PCT

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01/04/2011

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ALEXANDRIA, VA 22314

EXAMINER

DOUYON, LORNA M

ART UNIT

PAPER NUMBER

1761

NOTIFICATION DATE

DELIVERY MODE

01/04/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/523,814	<b>Applicant(s)</b> ISHIHARA ET AL.	
	<b>Examiner</b> Lorna M. Douyon	<b>Art Unit</b> 1761	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-17 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/2/10; 10/27/10</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2010 has been entered.

***Election/Restrictions***

2. Newly submitted claims 15, 16 and 17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 15, 16 and 17 are drawn to a method of masking acidic odor of an acidic hair composition, which is a different invention from the elected claims drawn to a fragrance composition.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15, 16 and 17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

**3.** Claims 2-17 are pending. Claim 1 is cancelled. Claims 11-17 are newly added. Claims 6, 8, 9 and 10 are currently amended. Claims 3-5, 15-17 are withdrawn from further consideration as being drawn to a nonelected invention.

**4.** All prior art rejections are withdrawn in view of Applicants' amendment and arguments therein.

***Claim Rejections - 35 USC § 103***

**5.** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**6.** Claims 2, 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (JP3200577), hereinafter "Watanabe".

Watanabe teaches a fluid composition which is used as cosmetics for skin or hair such as shampoos (see page 6, third full paragraph of the translation) comprising 0.5% by weight or more of an organic compound having a molecular weight of 300 or less, wherein the fluid is packed in an expandable elastic storing body, and wherein the organic compounds are mainly solvents, perfumes (see abstract; page 2, first full paragraph of the translation). The solvents include turpentine oil, pine oil, oil, etc. (see page 7, lines 13-19) which read on component II. Other solvents include esters like diethyl phthalate, benzyl benzoate, etc. (see page 7, lines 10-12). The perfumes include hydrocarbons like limonene and pinene (see page 7, lines 21-22) which read on

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component IV(C); esters like benzyl benzoate, benzoic acid ester, cinnamic acid ester (see page 8, lines 8-9) which read on component IV(B)(i); lactones like  $\gamma$ -nonyllactone (see page 8, lines 21-22) which read on component IV(B)(iii); ketones like methyl heptenone or cyclic ketones like acetophenone (see page 8, lines 23-27) which read on (B)(iv); musks (see page 9, lines 3-6) which read on component IV(A); and sulfur compounds such as furfuryl mercaptan or dimethyl sulfide (see page 9, lines 15-16) which read on (D). In Fluid Composition No. 6, Watanabe teaches a shampoo (which reads on a cleansing composition) which comprises 15 wt% by weight sodium polyoxyethylene alkyl ether sulfate (an anionic surfactant which reads on component I and meets the required amount); 2% by weight ethylene glycol distearate; 0.5% by weight citric acid (which read on component III and meets the required amount); 0.7% by weight Perfume F which contains musk, lemon oil, methyl ionone, among others; and water as the remainder ingredient (see entire pages 24-25). Watanabe, however, fails to specifically disclose a shampoo containing an oil and a perfume composition containing musk, lemon oil, benzyl benzoate, benzoic acid ester, cinnamic acid ester and/or lactones like  $\gamma$ -nonyllactone; and the pH of the shampoo.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared a composition comprising an oil and a perfume composition containing musk, lemon oil, benzyl benzoate, benzoic acid ester, cinnamic acid ester and/or lactones like  $\gamma$ -nonyllactone because these are some of the selection of solvent and perfume ingredients suggested by Watanabe in pages 7-9, and to

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reasonably expect the pH of the composition to be within those recited because similar components having overlapping proportions have been utilized.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe as applied to claim 6 above, and further in view of Grote et al. (US Patent No. 4,741,855), hereinafter "Grote".

Watanabe teaches the features as described above. Watanabe, however, fails to disclose silicone oil in the shampoo.

Grote, an analogous art, teaches a similar shampoo which comprises from about 0.1% to about 10.00% by weight of a non-volatile silicone fluid which delivers good hair conditioning (see abstract; col. 5, lines 60-67; col. 8, lines 67-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated silicone oil into the shampoo of Watanabe because this would deliver good hair conditioning as taught by Grote.

8. In the alternative, claims 2, 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Grote.

Watanabe teaches the features as described above. Watanabe, however, fails to specifically disclose a shampoo containing an oil like silicone oil and a perfume composition containing musk, lemon oil, benzyl benzoate, benzoic acid ester, cinnamic acid ester and/or lactones like  $\gamma$ -nonyllactone; and the pH of the shampoo.

Grote, an analogous art, teaches the features as described above. In addition, Grote teaches that the pH of the composition may be in the range of from 2 to about 10; preferably from about 2 to about 4 (see col. 7, lines 53-56), and the pH adjusting agents include citric acid (see col. 7, lines 46-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have prepared a composition comprising a perfume composition containing musk, lemon oil, benzyl benzoate, benzoic acid ester, cinnamic acid ester and/or lactones like  $\gamma$ -nonyllactone because these are some of the selection of solvent and perfume ingredients suggested by Watanabe in pages 7-9. It would also have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pH of the shampoo of Watanabe to be within those recited because it is known from Grote that a similar shampoo has a preferred pH in the range from about 2 to about 4; and to have incorporated silicone oil into the shampoo of Watanabe because this would deliver good hair conditioning as taught by Grote.

### ***Response to Amendment***

9. The two declarations under 37 CFR 1.132 filed on October 27, 2010, one by Ms. Takami Gema and the other by Mr. Hiroki Mizushima are insufficient to overcome the rejection of the present claims based upon the newly cited prior art to Watanabe, or Watanabe in view of Grote because: the showing has not been compared to the prior art of record. The declaration of Ms. Gema showed that a composition having a pH of 5 has a strong acidic odor compared to a composition having a pH of 6 which does not

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have a strong acidic odor; and the composition which contains 16 wt% of anionic surfactant has a strong acidic odor when compared to one with 1.5 wt% anionic surfactant. Watanabe, singly or in combination with Grote, however, teaches 15 wt% anionic surfactant (as discussed in paragraph 6 above) and a pH within those recited (i.e., about 2 to about 4, as discussed in paragraphs 6 and 8 above), hence, the showing has not been compared to the close prior art of record. The separate declaration by Mr. Mizushima showed a comparison between a formulation wherein one contains anionic surfactant and the other substituted the anionic surfactant with a nonionic surfactant, and this too is insufficient to overcome the prior art of record because the showing has not been compared to the close prior art to Watanabe.

### ***Response to Arguments***

10. Applicants' arguments with respect to claims 2, 6-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered cumulative to or less material than those discussed above.



12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/  
Primary Examiner, Art Unit 1761